



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,412	04/19/2004	Michael Freisthler	04047	- 2605

20879 7590 09/29/2005

EMCH, SCHAFFER, SCHAUB & PORCELLO CO
P O BOX 916
ONE SEAGATE SUITE 1980
TOLEDO, OH 43697

EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

1755

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,412

Applicant(s)

FREISTHLER, MICHAEL

Examiner

David M. Brunsman

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040621.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1755

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 10, 11, 13 and 15-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification contains no disclosure of products containing the 20-30% by weight range of claim 2. The specification contains no disclosure of products containing the combination of bitumen and the 4-component soybean product mixture of claims 10 and 11. Page 2, line 19 through page 9, line 10 of the instant specification are held over from the parent and disclose only said 4-component soybean product per se and do not address combinations thereof with bitumen. The specification fails to disclose saponification of the mixture of bitumen and soybean product. The specification contains no disclosure of stabilization of aggregate with a product containing bitumen.

The parent application discloses only soybean product compositions without an asphalt/bitumen component. The effective date of the disclosure necessary to support the instant claims is 19 April 2004, the instant filing date.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Art Unit: 1755

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 8, 9 and 14 are rejected under 35 U.S.C. 102(a or e) as being anticipated by US 2004/0195190.

Figure 9 of the reference discloses the combination of asphalt and 17% by weight methyl ester of soybean oil fatty acids. Page 2, line 8, discloses an endpoint composition of 20% methyl ester of soybean fatty acids in a heavy hydrocarbon (bitumen). Asphalt itself is a mixture of compounds various asphaltenes and maltenes and is considered to anticipate a "mixture" of asphalts. Claim 14 merely recites the intended future use of the product and is anticipated by any disclosure of the composition itself.

Claims 1, 2, 4, 6, 8, 9, 12, 14 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6764542.

Example 1 of the reference teaches an asphalt composition, and a method of using it to fill holes in asphalt pavement, comprising asphalt and 17% methyl ester of soybean oil (Biodiesel). Column 6, line 55, teaches an endpoint composition comprising 20% biodiesel. Column 7, line 67 teaches an endpoint composition comprising an asphalt emulsion containing 15% biodiesel. Asphalt itself is a mixture of compounds various asphaltenes and maltenes and is considered to anticipate a "mixture" of asphalts. Claim 14 merely recites the intended future use of the product and is anticipated by any disclosure of the composition itself.

Art Unit: 1755

Claims 1, 2, 3, 8, 9, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 2877129.

Example 2 of the reference teaches a composition comprising paving asphalt and 25% by weight soybean oil. Column 5, line 24 discloses an endpoint composition containing 40% by weight of the a liquid carboxylic ester such as the soybean oil of example 2. Asphalt itself is a mixture of compounds various asphaltenes and maltenes and is considered to anticipate a "mixture" of asphalts. Claims 14 and 22 merely recite the intended future use of the product and are anticipated by any disclosure of the composition itself.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2877129, as applied above.

The difference between the instant claims and the particular examples of the reference relied upon above is the ester employed. Column 2, line 60 through column 3, line 27 of the patent teaches the class of materials suitable for use as the liquid carboxylic ester. These compounds include the methyl ester of soybean oil fatty acids as well as soybean oil. It would have been obvious to one of ordinary skill in the art to select methyl soyate (or a mixture thereof with soybean oil) as the ester in the examples of the patent because it is taught to be functionally equivalent to those used.

Art Unit: 1755

Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest using the claimed composition in a method of *rejuvenating* bituminous surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunzman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunzman
Primary Examiner
Art Unit 1755

DMB

